



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,150	08/07/2003	Hiroshi Yoshikawa	051319-0045	1804
29619	7590	04/24/2006	EXAMINER	
SCHULTE ROTH & ZABEL LLP ATTN: JOEL E. LUTZKER 919 THIRD AVENUE NEW YORK, NY 10022			ALEXANDER, MICHAEL P	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/636,150	Applicant(s) YOSHIKAWA ET AL.	
	Examiner Michael P. Alexander	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is in condition for allowance except for the presence of claims 4-6 directed to an invention non-elected with traverse in the reply filed on 27 February 2006. Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Election/Restrictions

Applicant's election with traverse of group I in the reply filed on 27 February 2006 is acknowledged.

First, applicant argues that a "means for imparting an electrochemical dissolving effect" removes material from the surface of a workpiece and therefore cannot be used to practice electroplating. In response, the Examiner asserts that a "means for imparting an electrochemical dissolving effect" is instead something that is capable of imparting an electrochemical dissolving effect. The Examiner notes that claims 4-6 are directed to apparatus, which is defined by its structure and not its intended use. Therefore, the Examiner maintains that the apparatus can be used to practice electroplating.

Second, applicant argues that the claimed apparatus cannot be used to practice electroplating because the high speed of the electrolyte flow will prevent metal from

Art Unit: 1742

depositing properly on the surface of the workpiece. In response, firstly, the Examiner notes that the claims do not specify that the electrolyte would be flowing at a high speed. Secondly, the Examiner disagrees with applicant's assertion that a flowing electrolyte would prevent metal from depositing. In fact, the patent classification system devotes an entire subclass (see 205/148) to agitating an electrolyte during electrolytic deposition. Therefore, the Examiner maintains that the apparatus can be used to practice electroplating.

Third, applicant argues that the Examiner did not prove serious burden. In response, the serious burden is shown (as stated) by different classifications and also by the need to search the electroplating art for the claimed apparatus.

Fourth, applicant argues that the search burden is unlikely to be serious when all the limitations of group I appear nearly word-for-word in group II. In response, the Examiner notes that the applicant has presented no case precedent, evidence or convincing rationale to show that similarity of wording gives a presumption of lack of serious search burden. And if even it did, in the instant case there is a serious search burden shown by the need to search the separate classification of the apparatus claims and also by the need to search the electroplating art for the claimed apparatus.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 27 February 2006.

Allowable Subject Matter

Claims 1-3 are allowed.

The following is an examiner's statement of reasons for allowance: the prior art does not teach directing an electrolyte from a common electrolyte tank to each of the machining devices used on multiple workpieces, each of said workpieces serving as part of a fluid dynamic pressure bearing, in combination with the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mpa

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

~~ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700~~